

File

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 07 1996

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARVEY FINKELSTEIN,
VICTOR FLORES and
MURRAY SINGER

Appeal No. 95-0806
Application 07/755,733¹

ON BRIEF

Before CALVERT, LYDDANE and GARRIS, Administrative Patent Judges.
LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 6, 9, 10, 16 and 18 through 20. Claims

¹ Application for patent filed September 6, 1991.

Appeal No. 954-0806
Application 07/755,733

11 through 15, which are the only other claims pending in the application, stand withdrawn from further consideration by the examiner pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

The subject matter on appeal is directed to a cap liner in the form of a disk that includes an intermediate resilient foamed layer of a homogeneous admixture of polyethylene and polypropylene and at least one outer layer of a substantially homogeneous admixture of polyethylene and polypropylene. Claims 6 and 16² are exemplary of the invention and a copy thereof, as they appear in the appendix to the appellants' brief, has been appended to this decision.

The references of record relied upon by the examiner in rejections of the claims under 35 USC 103 are:

²We have observed that claim 16 was apparently inadvertently miscopied when it was presented in the amendment of Paper No. 7, dated August 17, 1993. Claim 16, as it appeared in the record prior to that amendment, included the expression "and said intermediate layer comprising a resilient foamed admixture of polyethylene and polypropylene" following the word "polypropylene" in line 8 thereof. However, as presented in the amendment of Paper No. 7, this expression did not appear. Had appellant intended to intentionally delete this expression by amendment, it would have appeared in the claim as amended in brackets, consistent with 37 CFR 1.121(c), since the portions of the claim that were added were underlined, also consistent with 37 CFR 1.121(c). Consequently, we have interpreted claim 16 to include this limitation which was inadvertently omitted, but the appellants should correct claim 16 by formal amendment consistent with this interpretation.

Appeal No. 954-0806
Application 07/755,733

Tagalakis et al. (Tagalakis)	4,121,728	Oct. 24, 1978
Heider	5,079,057	Jan. 7, 1992
		(filed Oct. 31, 1989)

Claims 6, 9, 10, 16 and 18 through 20 stand rejected under 35 USC 102(e) as being anticipated by Heider.

Claims 6, 9, 10, 16 and 18 through 20 stand rejected under 35 USC 103 as being unpatentable over Heider.

Claims 16 and 18 through 20 stand rejected under 35 USC 103 as being unpatentable over Tagalakis in view of Heider.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellants, we refer to pages 3 through 7 of the examiner's answer, to pages 5 through 13 of the appellants' brief and to the appellants' reply brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish either an anticipation or a prima facie case of obviousness with respect to any of the claims on appeal. Our reasoning for this determination follows.

Appeal No. 954-0806
Application 07/755,733

With respect to the examiner's rejection of claims 6, 9, 10, 16 and 18 through 20 under 35 USC 102(e) as being anticipated by Heider, we initially observe that an anticipation under § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984), cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp., 468 U.S. 1228 (1984). Additionally, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983) cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985).

It is apparent from reading the claims on appeal that appealed claim 6 positively recites a "cap liner in the form of a disk" and that independent claim 16 positively recites a closure liner that includes a cap and a "cap liner positioned inside said cap comprising a disk" contrary to any view that the examiner may have that such expressions are merely statements of intended use. While we agree with the examiner that the patent to Heider discloses a "label having one or more outer layers and an

Appeal No. 954-0806
Application 07/755,733

intermediate layer position [sic, positioned] against or sandwiched between the outer layers (see Figure 2)" (answer, page 3), such label is clearly not a cap liner, nor is it "in the form of a disk" or "comprising a disk" as required by claims 6 and 16, respectively. Furthermore, we also cannot agree that the label of Heider forms the intermediate layer of a "resilient foamed homogenous admixture of polyethylene and 10-98% of polypropylene" or the outer layers of "a substantially homogeneous admixture of polyethylene and 10-98% polypropylene" as required by the claims on appeal. Therefore, it is clear that Heider does not include every element recited in appealed claims 6 and 16, and we cannot sustain the examiner's rejection of these claims, or of claims 9, 10 and 18 through 20 dependent thereon, under 35 USC 102(e).

With respect to the examiner's rejections of the claims under 35 USC 103, we observe that in rejecting claims under § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147

Appeal No. 954-0806
Application 07/755,733

(CCPA 1976)). A rejection based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has also repeatedly cautioned against employing hindsight by using the applicants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). Like the appellants, we think that the examiner has relied here on impermissible hindsight to provide the missing motivation to modify the teachings of Heider and to combine the teachings of Tagalakis and Heider in the

Appeal No. 954-0806
Application 07/755,733

proposed rejections. That being the case, the rejection cannot be sustained.

In particular, in rejecting claims 6, 9, 10, 16 and 18 through 20 under 35 USC 103 over Heider alone, the examiner admits that Heider fails to teach that the label disclosed therein has a "disc shape" (answer, page 4), and it is clear that Heider does not disclose a cap liner. Then, the examiner concludes that it would have been obvious "to use the label disclosed by Heider and cut to the preferred shape using the cutting knives including a disc shape" (answer, page 4). As noted above, rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, supra. In our view, this is precisely what the examiner has done in arriving at the § 103 rejection of these claims based on Heider alone. Thus, we cannot sustain the examiner's rejection of claims 6, 9, 10, 16 and 18 through 20 on this basis.

Considering next the examiner's rejection of claims 16 and 18 through 20 based on the combined teachings of Tagalakis

Appeal No. 954-0806
Application 07/755,733

and Heider, while we agree that Tagalakis discloses a cap liner having a foamed intermediate layer sandwiched between outer layers similar to that claimed by appellants, we do not agree with the examiner's position that the "outer layers are comprised of polyethylene and polypropylene" or that the intermediate layer comprises "a blend of polyethylene and polypropylene" (answer, page 5, emphasis added). Tagalakis discloses only that

the plies 12, 14 are constructed from impermeable polymeric or copolymeric material while the ply 13, though constructed of polymeric or copolymeric material, is preferably foamed, typical of such material being polyethylene, polypropylene, etc.
[column 4, lines 14-18, emphasis added]

Nowhere is it disclosed that the outer layers are comprised of both polyethylene and polypropylene or that the foamed intermediate layer includes a blend of polyethylene and polypropylene.

Even assuming arguendo that Heider discloses blends of polyethylene and polypropylene for the layers of his label, we do not find the teachings of the label of Heider to be analogous to the teachings of the cap liner of Tagalakis, nor do we find any teaching, suggestion or motivation in Tagalakis and Heider, or from any knowledge clearly present in the prior art, for the combination of the teachings of Tagalakis and Heider as proposed by the examiner in the rejection of appealed claims 16 and 18 through 20 based thereon. We note that the two-part test for

Appeal No. 954-0806
Application 07/755,733

determining whether or not a reference is from an analogous art is set forth in In re Wood, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979). First it is to be determined if the reference is within the field of the inventor's endeavor; if it is not, then it is to be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Appellants' field of endeavor is that of providing a liner for a cap utilized as a closure for a container, as is that of Tagalakis, whereas Heider is concerned with affixing a label to the outside of a container. Moreover, appellants were concerned with the problem of providing an economical and effective cap liner for containers that would not melt or weaken when filled with a hot material, whereas Heider was concerned with the problem of affixing a label to a container without the use of adhesives. Thus, it is our opinion that the patent to Heider is nonanalogous prior art under both parts of the two-part test, and therefore not properly combinable with the teachings of Tagalakis in the rejection of the claims on appeal.

Furthermore, as stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a

Appeal No. 954-0806
Application 07/755,733

hindsight syndrome wherein that which only
the inventor taught is used against its
teacher.

It is our conclusion that the only reason to combine the
teachings of Tagalakis and Heider in the manner proposed by the
examiner results from a review of appellants' disclosure and the
application of impermissible hindsight. Thus, for the above
reasons we also cannot sustain the examiner's rejections of
appealed claims 16 and 18 through 20 under 35 USC 103 based on
the combined teachings of Tagalakis and Heider.

Accordingly, the decision of the examiner rejecting
claims 6, 9, 10, 16 and 18 through 20 under 35 USC 102(e) and
under 35 USC 103 is reversed.

REVERSED



IAN A. CALVERT)
Administrative Patent Judge)



WILLIAM E. LYDDANE)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES



BRADLEY R. GARRISS)
Administrative Patent Judge)

Appeal No. 954-0806
Application 07/755,733

Frank P. Presta
Lowe, Price, LeBlanc & Becker
Suite 300
99 Canal Center Plaza
Alexandria, VA 22314

APPENDIX

6. A cap liner in the form of a disk having an intermediate layer for positioning against the inside of the cap and a lower outer layer bonded to said intermediate layer, said intermediate layer comprising a resilient foamed homogenous admixture of polyethylene and 10-98% of polypropylene, and said outer layer comprising a substantially homogenous admixture of polyethylene and 10-98% of polypropylene.

16. Closure liner for a container having a neck portion and a rim portion which defines a container opening, said closure liner comprising a cap which is operable to be received on the neck portion, a cap liner positioned inside said cap comprising a disk having a pair of outer layers and an intermediate layer sandwiched between said outer layers and co-extruded thereto, said outer layers comprising a substantially homogenous admixture of polyethylene and 10-98% of polypropylene, said liner being positioned in said cap such that when said cap is positioned on the neck portion, one of said outer layers is positioned against an inside top portion of said cap, the other outer layer engages the container rim portion and covers the opening, and said intermediate layer is compressed to provide an effective seal between said cap liner and the container which does not structurally or functionally degrade when exposed to heat from a hot filled container.